

U.S. Serial No.: 09/811,702

REMARKS**I. Introduction**

Claims 1, 4, 5, 8, 9, 12 and 13 are pending in the above application.

Claims 1, 4, 5, 8, 9, 12 and 13 stand rejected under 35 U.S.C. § 103.

II. Rejection Under Prior Art

Claims 1, 4, 5, 8, 9, 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over McMullan Jr. (U.S. Pat. 5,251,324) in view of Jung (6,678,893).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there **is some teaching, suggestion, or motivation to do so** found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also MPEP 2143.01. It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). Recognizing, after the fact, that such a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 379 f.2d 1011, 154, USPQ 173 (CCPA 1967).

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As explained in Applicant's previous response submitted on October 13, 2005, neither McMullan Jr., Jung, taken alone or in combination, disclose or suggest all of the claimed limitations of any of independent claims 1, 5 and 9. McMullan discloses a set top box which can support pay per view impulse purchasing (IPPV) by an upstream communication to the CATV headend. McMullan, col. 11: 7-68. McMullan discloses that "upon completion of transmission, microprocessor 504 also switches the RF circuitry off, thus reducing the noise output of the module and reducing the overall power demand." However, McMullan does not disclose a CPLD which generates an amplifier switch signal for connecting the upstream amplifier to an RF tuner for transmission of the upstream data signal to the headend, and which generates an amplifier control signal for powering on and off said upstream amplifier, wherein the CPLD generates the amplifier switch signal after the amplifier control signal is generated, thereby stabilizing said upstream amplifier. Jung also does not disclose such feature.

Jung discloses a bidirectional trunk amplifier which uses an upstream pilot signal when requested by the headend. Jung, abs.; col. 4: 55-60. Jung does not disclose or suggest to turn off an amplifier at all, let alone the upstream amplifier. In fact, as Jung primarily uses a bidirectional amplifier, turning off the bidirectional amplifier would also likely inhibit receipt of downstream communications, rendering it impossible for the "request" for an upstream pilot signal from the headend to be received by CPU 609 in the system of Jung. Jung; col. 4: 48 through col. 5: 17. In any case, Jung's discussion of when to generate an upstream pilot signal has no bearing on when to turn on or off the amplifier.

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The Office action appears to take issue with Applicant's characterization of the McMullan reference, but still appears to agree that the CPLD element (or at least portions thereof), as recited in the claims are not disclosed by McMullan. While the Office action appears to somehow justify parsing the CPLD into parts of the claimed element which are allegedly disclosed by McMullan and parts which are admittedly not disclosed, the Examiner is respectfully reminded that the claims must be considered as a whole, not in piecemeal manner. See, MPEP § 2141, third heading "when applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole." The arguments presented by in the Office action make it crystal clear that the claims are not viewed as a whole but rather as bits and pieces which are being attempted to be cobbled together to make a rejection. Such tactic is clearly improper and the rejection should be withdrawn.

The Office action further alleges that Jung does disclose to turn off an upstream amplifier and states:

The RF Amplifier 612 is clearly a piece of the Pilot Signal Generator 610, and when the Pilot Signal Generator 610 is turned off [col. 4, lines 49-60], the Amplifier is therefore also turned off. The Amplifier being a part of the Signal Generator 610 clearly shows that when the Signal Generator is turned on/off, so is the Amplifier.

Final Office action, pg. 3. While the RF Amplifier 612 clearly is a part of the Pilot Signal Generator circuit 610, it clearly is not an "upstream amplifier for receiving synchronized upstream communication signals from said MAC chip" as recited in claim 1, for example. Jung explicitly discloses an upstream amplifier (as part of bidirectional

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amplifier 102 in Figure 2) which receives signals from a MAC 206, in addition to disclosing the RF Amplifier 612. Clearly, RF Amplifier 610 does not receive upstream communication signals from MAC 206 in Jung. Jung, Fig. 6. Even when RF Amplifier 610 is deactivated, bidirectional amplifier 102, which actually transmits upstream signals from MAC 206, is still active in the Jung reference. In short, contrary to the conclusions in the Office action, Jung does not disclose or suggest to turn off an upstream amplifier which receives communications from a MAC chip.

Moreover, the fact that Jung fails to turn off an upstream amplifier associated with a MAC chip, while turning off a circuit having RF Amplifier 610 as a component, teaches away from turning off the upstream amplifier and makes it clear that the rejection is based on impermissible hindsight. In short, as Jung itself does not turn off bidirectional amplifier 102, there is clearly no motivation to modify McMullan Jr. to turn off an upstream amplifier based on the teachings of Jung.

Accordingly, as neither McMullan Jr. nor Jung, taken alone or in combination, disclose or suggest all of the limitations of independent claims 1, 5 and 9, the combination of McMullan Jr. and Jung does not render those claims, nor claims, 4, 8 and 12-13 which depend on claims 1, 5 and 9, respectively, unpatentable.

Furthermore, it is clear that the rejection is based on an attempt to recreate Applicant's invention piecemeal using improper hindsight considerations. In this vein, the Office action clearly is attempting to not only dissect Applicant's claims, but dissects individual elements of the claims, to attempt to locate individual portions of those elements in the prior art. The Office action is also attempting to rip a common circuit element (e.g. an amplifier) out of pilot signal generating circuit and use it as a substitute

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to an upstream amplifier. As the Jung reference itself maintains both the RF Amplifier 612 and bidirectional amplifiers, there is clearly no suggestion for such modification in Jung. There can be little question that the only rationale for combining the elements in the manner suggested by the Office action is from following the trail blazed by Applicant. Clearly, the rejection bears all of the classic hallmarks of improper hindsight and is clearly improper.

Accordingly, Applicant respectfully requests the rejection to be withdrawn.


III. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

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Respectfully submitted,

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